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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/764,352 | 01/19/2001 | Takahiro Masuda | 1046.1234/JDH | 7139 |

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| EXAMINER | |
|---|---|
| CHOW, CHIH CHING | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2191 | |

DATE MAILED: 06/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/764,352 | MASUDA ET AL. | |
| | Examiner | Art Unit | |
| | Chih-Ching Chow | 2191 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *01 March 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *4/9/04* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *4/16/01*.
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. *5/3/06, 5/12/06* .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

1. This action is responsive to amendment dated March 1, 2006.

2. Per Applicants' request, claims 1, 4, 5, 9, 10, 11, 12, and 13 have been amended, claim 14 is new.

3. Claims 1-14 remain pending.

### Response to Amendment

4. The examiner has reviewed the Applicants' amendment filed on 03/01/2006, responding to the 10/03/2005 Office action provided in the 35 USC § 101 rejections for claims 1, 4, and 13 respectfully. The examiner is maintaining the 35 USC § 101 rejections for the reasons below.

5. The examiner has reviewed the Applicants' explanation for Foreign Priority document filed on 01/19/2001, responding to the 10/03/2005 Office action provided in the objection of 'Priority' respectfully. The objection to the priority is hereby withdrawn in view of Applicants' Foreign Priority document.

6. The examiner has reviewed the Applicants' amendment filed on 03/01/2006, responding to the 10/03/2005 Office action provided in the 35 USC § 112 (1) rejections for claims 5, and 13 respectfully. The rejection to the 35 USC § 112(1) rejections is hereby withdrawn in view of Applicants' amended claims 5 and 13. However, the examiner is maintaining the 35 USC § 112 (2) rejections for claims 1, 2 and 3, see 35 USC § 112 (2) below.

### Response to Arguments

7. Applicant's arguments with respect to claims 1-13 have been considered but are moot in view of the new ground(s) of rejection necessitated by Applicant's amendments to the claims. See 35 USC § 103 rejections (claims include the amendments) herein below.

## *Claim Rejections - 35 USC § 101*

8. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-3, 4, 13, and 14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 recites: "An installation method of an application program comprising:
extracting a feature point in a data file after having analyzed the data file based on a stored feature point, the feature point being a content within the data file and indicative of a format used to create the data file;
selecting a version of the application program suited for the data file based on the extracted feature point;
determining whether the selected version of the application program is already installed; and
installing the selected version of the application program upon determining that the version of the application program is not installed."

There is a problem when the determining falls into the application program is already installed, nothing is addressed for this situation – no useful, concrete, and tangible results are produced. Claims 2-3 fail to cure the deficiency in claim 1 and is rejected for the same reason as in claim 1.

10. Claim 4 is rejected for not providing a storage medium in the claim

11. Claims 13 and 14 are rejected for the same reason as claim 1.

## Claim Rejections - 35 USC § 112

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

13. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. A telephone interview was conducted on 10/3/2006, the examiner has brought up questions for the Applicant representative to clarify for the 35 USC § 112 (2) rejections. Claim 1 recites: "the feature point being a content within the data file" – however the feature point is a broad concept, it should be limited to 'reserved words of macro instruction' (see Abstract of the current application)"; also claim 1 recites: "extracting a feature point in a data file after having analyzed the data file based on a stored feature point, the feature point being a content within the data file" -- it's not clear from the Specification how does the 'extracting a feature point in a data file' is done, the examiner assumes that the 'feature point' is predetermined at a certain point (for example, see FIG. 3, item 4, the 'AAAAA', 'BBBBB' ....etc. are all predetermined feature points), and they are stored in a data file, the ones need to be extracted are all predetermined somehow.

14. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 recites: "the feature point is a reserved word of a macro instruction included in the data file, and the version of the application program is decided by extracting the reserved word and determining the version of the application program enabled to read the reserved word" – if the version is decided by the extracted reserve words, that means the reserved word is already been read/extracted, why does it need to be read again as recited in the claim 'application program enabled to read the reserved word"?

15. Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It's not clear how does the 'extracting the syntax pattern' is done, and what are the 'syntax patterns', shouldn't they also be 'reserve words of the macro instruction'? Otherwise how can they be compiled?

16. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 14 recites: "A method of installing application programs, comprising: determining a version of a first application program used to create a document file a user is requesting to access from a content within the document file; and installing the version of the first application program or a second application program similar to the first application program and able to read the document file in accordance with said determining of the version of the first application program from the content within the document file." – it's not clear to the Examiner what is the 'document file'? Is it the reserved word/feature point file? The Examiner assumes that the 'content within the document file' is the 'reserved words of the feature points". It's also not clear what does the 'installing the version of the first application program or a second application program similar to the first application program' mean. The Examiner assumes it has the same meaning as claim 1.

## Claim Rejections - 35 USC § 102

17. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

18. Claims 1, 8, 11-14 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6199204 by Donohue.

| CLAIMS | Donohue |
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| 1. An installation method of an application program comprising:<br>(a) extracting a feature point in a data file after having analyzed the data file based | Donohue teaches a method for automatically installing computer programs. For item a, in Donohue's invention column 8, line 32-35, |

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| on a stored feature point, the feature point being a content within the data file and indicative of a format used to create the data file; | "Assuming that software vendors provide via their Web sites a list 60 of available product updates referenced by **product identifier** and **release number** 110 (or some other consistent naming convention is used)"; the 'extracting' is done in Donohue, see column 4, lines 14-21, "compares the available relevant updates with **update criteria held on the local computer system** (these update criteria are predefined for the current system or system user), and then automatically downloads and applies software updates which satisfy the predefined criteria." – the predefined criteria needs to be extracted in order to be compared; the 'feature point' can also be used as an indicative of an installation data, see example in Donohue's disclosure, column 10, lines 16-20, "the software product to be updated may be a word processor application program. If the word processor as sold missed certain fonts or did not include a thesaurus, patches may subsequently be made available for adding these features. The updater component has the capability to add these to the word processor, subject to the update criteria". Donohue's a list of product identifier and release numbers are also stored in data file. Since the feature point is broad in this claim (see 112 (2) rejection above) therefore Donohue's teaching still reads on the current application. For item (b), the "release number" is the same as the "version of an application" (item (b)). On Donohue's Fig. 2, the table shows the software product identifier along with the associated version number. Therefore, once a 'feature point' is identified (extracted) the version number can be |
| (b) selecting a version of the application program suited for the data file based on the extracted feature point, | |

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| | determined (claim 1 (a), (b)). |
| (c) determining whether the selected version of the application program is already installed; and | Donohue column 8, line 65-67 shows "a comparison 250 between the current installed software product's identifier and release number and the listed available updates in the retrieved file 160. This comparison determines possible growth paths form the current to updated versions... Thus, the updater component determines whether the available new versions and whether it is possible to apply patches to the current version..." The comparison is determining whether an application should be installed (claim 1 (c)). |
| (d) installing the selected version of the application program upon determining that the version of the application program is not installed. | Assuming this means install the application program if it's not currently installed yet (see rejection on 112 2nd paragraph for claim 1 (d)). Donohue teaches the feature extracting and version comparison, but does not install the software unless the software meets the 'predefined update criteria'. |
| 8. The installation method mentioned in claim 3, further comprising: eliminating an existing file if insufficient space exist when the application program is executed. | See 112 (2nd) rejection above. It's well-known for the people in the art that when installing new file into a computer, if insufficient space occurred, the computer will put out a warning for the user, the user will have to eliminate existing file in order to restore more space in the computer. |
| 11. An apparatus for installing an application program, comprising: (a) an extracting unit extracting at least one of a plurality of feature points in a data file after having analyzed the data file; the feature point being indicative of a format used to created the data file; (b) a selecting unit selecting a version of | See claim 1 rejection. |

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| the application program suited for the analyzed data file based on an extracted feature point;<br>(c) a judging unit judging whether the application program of a decided version is already installed; and<br>(d) an installation unit installing the application program of the version when the decided version of the application program is not installed. | |
| 12. A storage medium storing an application program, which when executed by a computer, sequentially executing:<br>(a) extracting at least one of a plurality of feature points of a data file after having analyzed the data file, the feature point being indicative of a format used to create the data file; | The program is executing the updates has to be stored somewhere in the system in order to be executed. For item (a), see the rejection of claim 1 (a). |
| (b) selecting a version of the application program suited for the analyzed data file based on an extracted feature point; | See the rejection of claim 1(b). |
| (c) judging whether the application program of a decided version is already installed; and | See the rejection of claim 1 (c). |
| (d) installing the application program of the version when the decided version of the application program is not installed. | See the rejection of claim 1(d). |
| 13. A method of automatically installing an application program, comprising:<br>(a) analyzing a data file to determine a format thereof and determining a version of an application program used to create the data file based on the determined format of the data file; and<br>(b) automatically installing the version of the application program or a substantially similar version of another application program able to read the data file upon | For item (a) see claim 1 rejection, for item (b), see 112(1) rejection above. |

determining that a suitable application program to read the data file is not installed.

14. (new) A method of installing application programs, comprising: determining a version of a first application program used to create a document file a user is requesting to access from a content within the document file; and installing the version of the first application program or a second application program similar to the first application program and able to read the document file in accordance with said determining of the version of the first application program from the content within the document file.

## Claim Rejections - 35 USC § 103

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

20. Claims 4-7, 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6199204 by Donohue, as applied to claims above, in view of U.S. Patent No. 6282712 by Davis et al (herein after Davis).

| CLAIMS | Donohue / Davis |
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| 4. An activation method of an application comprising:<br>(a) extracting at least one of a plurality of feature points in at least two data files after having analyzed the data files, the feature points being contents within the data files and indicative of corresponding formats used to create the data files; | In Donohue, column 7, lines 62, Each vendor is assumed here to make available via their Web Sites such a list 60 of software updates (an example of which is shown in Fig. 2). Fig. 2 shows software updates list and retrieved software list; both the data file and the application program are **displayed** in web site for the |

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| (b) selecting a version of the application program in which a data file is readable based on at least one of the feature points; | user to access. Therefore it covers item (c). Donohue's list is also being stored within a data file. Donohue teaches the means of 'retrieving' (*activating*) the application program. In Donohue's claim 1, 3rd and 4th items, "means for **initiating retrieval** of software update resources which satisfy said predefined criteria; and means for applying a software update to one of the installed computer programs using the **one or more** retrieved software resources." Donohue also teaches the 'feature points being indicative of corresponding formats used to create the data files", see claim 1 (a) rejection. |
| (c) displaying simultaneously the readable data file and the application program of a version decided thereby; and | |
| (d) activating the displayed application program in relation to any one of the analyzed data files. | Donohue teaches all the aspects of claim 4, but Donohue doesn't specifically allow the user to select certain application program, item (d). However Davis shows the feature to allow the user to manually select an application program in an analogous art for the purpose of ensure that the application program installation is necessary and appropriate (implied from Davis BACKGROUND OF THE INVENTION). In Davis' claim 1, 4th and 5th items, "**selecting an edition** of the software....", "automatically installing the **selected edition** of the software onto the new computer ...". It would have been obvious to a person of the ordinary skill in the art at the time of the invention to modify Donohue's updating software application disclosure with the user selection feature taught by Davis for the purpose of facilitating the installation of software within their distributed system (See Davis BACKGROUND OF THE INVENTION). |
| 5. The activation method mentioned in | For the features of claim 4 see Donohue |

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| claim 4, wherein: the readable data file is displayed with a figure corresponding to the application program. | and Davis. Davis' disclosures display user readable 'symbol figure' for user to select. See claim 4 rejection. |
| 6. The activation method mentioned in claim 4, wherein: only the readable data file corresponding to a version of the application program is displayed when the application program is selected. | Same as claim 4 rejection. |
| 7. The activation method in claim 4, wherein: the installation of a corresponding application program is executed when an application program corresponding to the data file does not exist. | Same as claim 4 rejection. |
| 9. A computer-readable medium on which an application program is recorded, the application program when executed by the computer, causes the computer to execute the functions comprising: | In Donohue's claim 1, "A computer program product, comprising computer program code recorded on a computer readable **recording medium**, ..." Here Donohue teaches us a record medium for a software update system. For claim 9 (a) see the rejection of claim 4 (a). |
| (a) extracting at least one of a plurality of feature points in at least two data files after having analyzed the data files, the feature points being indicative of corresponding formats used to create the data files; | |
| (b) selecting a version of the application program which can read the readable data file based on at least one of the feature points; | See the rejection of claim 4 (b). |
| (c) displaying simultaneously the readable data file and the application program of a version decided thereby; and | See the rejection of claim 4 (c). |
| (d) activating the displayed application program in relation to any one of the analyzed data files. | See the rejection of claim 4 (d). |
| 10. An apparatus for executing an application program, comprising: | See the rejection of claim 4 (a). |

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| (a) an extracting unit extracting at least one of a plurality of feature points of at least two data files after having analyzed the data files, the feature points being indicative of corresponding formats used to create the data files; | |
| (b) a selecting unit selecting a version of the application program which can read the readable data files based on at least one of the feature points; | See the rejection of claim 4 (b). |
| (c) a displaying unit simultaneously displaying the readable data file and the application program of a version decided thereby; and | See the rejection of claim 4 (c). |
| (d) an activating unit activating the displayed application program in relation to any one of the analyzed data files. | See the rejection of claim 4 (d). |

**Conclusion**

The following summarizes the status of the claims:

35 USC § 101 rejection: Claims 1, 4, 13, 14

35 USC § 112 (2) rejection: Claims 1-3, 14

35 USC § 102 rejection: Claims 1, 8, 11-14

35 USC § 103 rejection: Claims 4-7, 9-10

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Ching Chow whose telephone number is 571-272-3693. The examiner can normally be reached on 7:30am - 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wei Zhen can be reached on 571-272-3708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Any inquiry of a general nature of relating to the status of this application should be directed to the **TC2100 Group receptionist: 571-272-2100**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chih-Ching Chow

Examiner

Art Unit 2191

May 25, 2006

CC

WEI ZHEN
SUPERVISORY PATENT EXAMINER